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PATENT APPLICATION

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE HONORABLE BOARD OF PATENT APPEALS AND INTERFERENCES

In re the Application of

Noriyoshi OKUZONO et al.

Group Art Unit: 3723

Application No.: 10/596,724

Examiner: D. NGUYEN

Filed: June 22, 2006

Docket No.: 145181

For: CORE FOR WASHING SPONGE ROLLER

REPLY BRIEF

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

The following remarks are directed to the new points of argument raised in the Examiner's Answer dated June 14, 2011.

The Examiner's Answer continues to reverse the required burdens between the Patent Office and the Appellants regarding what must be proved *by the Patent Office* to support a *prima facie* case of obviousness, and what must be provided by the Appellants to rebut a *prima facie* case of obviousness.

It is not incumbent upon an Applicant/Appellant to rebut a *prima facie* case of obviousness that simply has not been made. In the Background section of Appellants' disclosure, Appellants specifically draw attention to U.S. Patent No. 6,240,588 to Dickey. *See* paragraph [0007] of U.S. Patent Application Publication No. 2007/0163066 A1 to Okuzono et al. At paragraphs [0011] - [0013], Appellants specifically note the following

shortfalls in "conventional devices," such as those disclosed in Dickey. Specifically, "there was a problem that the supply of a cleaning fluid from a core to a sponge roller was extremely nonuniform, and thus it was difficult flow out the cleaning fluid evenly over the outer surface of the roller." *See* paragraph [0011]. Additionally, Appellants' Background section points out that "in the cleaning step a plurality of different types of liquid fluid are often used in turn." *See* paragraph [0012]. Another specific shortfall in the prior art that Appellants' disclosure points out regarding devices such as that disclosed in Dickey is that "when the cleaning fluid in use is changed to another cleaning fluid, there is a problem that the cleaning fluid previously used remains in the bore of a core or in a cleaning sponge roller, and it took a long time to change the cleaning fluid." *Id.*

Appellants' disclosure goes on to state that the subject matter of the pending claims is directed to a core for a cleaning sponge roller that makes it "possible to distribute a cleaning fluid evenly over the entire outer surface area of the core," *i.e.*, "evenly to the sponge roller." *See* paragraph [0013]. The structure recited in the pending claims is also indicated as facilitating replacement of the cleaning fluid "quickly upon change of the cleaning fluid." *Id.* Appellants' disclosure explains that "[i]n the core of the conventional sponge roller [such as that disclosed in Dickey], the very small area of opening portion of small holes in communication with the bore portion was one of the reasons that the supply of the cleaning fluid to the sponge roller was extremely uneven and therefore it was difficult to flow out the cleaning fluid evenly over the outer surface of the roller." *Id.*

Appellants' disclosure clearly recognizes the criticality to the combination of all of the features positively recited in claim 1. That conclusion notwithstanding, however, the Office Action, and now the Examiner's Answer, do not present a *prima facie* case of obviousness that the Appellants would have to rebut with any positive evidence of criticality, as the Examiner's Answer demands.

In response to Appellants' well made arguments in Appellants' April 20, 2010 Response to the then-pending Office Action, the June 15, 2010 Final Rejection, to which this Appeal is addressed, explains that "Applicant argues that Dickey fails to teach and would not have rendered obvious the claimed structure of independent claim 1 and both diameters of the bore and small holes are much smaller of claim 1." *See* paragraph 3 on page 3. To the extent that this statement inappropriately truncates the arguments that Appellants made in prosecution of this application, the attempt at rebuttal falls equally short. The June 15 Final Rejection states that "[t]he argument is not persuasive since applicant is not provide [sic] evidence to show that the claimed ranges of claim 1 are critical by showing that the particular ranges achieve unexpected results relative to the prior art ranges." *See* paragraph 3 on page 3. This assertion is in error.

At pages 4 and 5 of Appellants' Remarks in the April 20, 2010 Amendment, Appellants specifically state the above-described advantages to the structure recited in the pending claims. Additionally, Appellants' arguments go on to state that "[u]sing the conventional wisdom, as demonstrated by Dickey, when a person of ordinary skill wants to distribute or replace a cleaning liquid as quick as possible, the person of ordinary skill would consider making a cross sectional area in a downstream side smaller so as to increase a pressure of liquid." The structure that may be suggested by Dickey is completely opposite to that recited in the pending claims. Despite these well-made arguments in the April 20, 2010 Response, the June 15 Final Rejection alleges that Appellants have failed to provide what the Examiner would conclude is a critical showing that the particular ranges achieve unexpected results. It is unclear what more Appellants would need to do even if the assertions in the Office Action were correct.

Regarding the specific assertions in the Final Rejection, as was made clear in Appellants' Brief on Appeal, Dickey discloses that the recited bore has a diameter, a range of

which is below and outside the claimed range recited in independent claim 1. *See* the first paragraph on page 13 of Appellants' Brief on Appeal. Dickey recognizes that decreasing the diameter of the bore allows for rapidly filling the volume of the brush core. *See* the second full paragraph on page 13 of Appellants' Brief on Appeal. Regarding the small holes in Dickey, the range of the small holes is also below and outside the range recited in independent claim 1. *See* the third full paragraph on page 13 of Appellants' Brief on Appeal. The June 15 Final Rejection recognized the distinct differences between the claimed ranges and the prior art ranges. The June 15 Final Rejection conceded that "Dickey et al. does not disclose expressly the diameter of the bore [in the recited range], diameter of small holes [in the recited range], a total of cross-sectional areas of the openings of the plurality of small holes is larger than across section area of the bore [in the recited range]." *See* page 2. The June 15 Final Rejection alleges, however, that "[i]t would have been obvious to one of ordinary skill in the art at the time the invention was made to select the [claimed] ranges, since it has been held that where the general conditions of the claim are disclosed in the prior art, discovering the optimum more workable ranges involves only routine skill in the art." *See* pages 2-3. The June 15 Final Rejection effectively quotes MPEP §2144.05 II. A. What the June 15 Final Rejection, the Advisory Action and now the Examiner's Answer fail to take into account is the admonition in MPEP §2144.05 II. B. (the very next sub-section of the guidance), which explicitly states "[a] particular parameter *must first be recognized as a result-effective variable, i.e.,* a variable which achieves a recognized result, before the determination of the optimum or workable ranges of said variable might be characterized as routine experimentation" (citation omitted, emphasis added).

Throughout prosecution of this application, and now on Appeal, Appellants have effectively argued that no such showing has been made. In fact, the Advisory Action, and now the Examiner's Answer, as indicated above, convolutes the showing required. The

Advisory Action specifically and improperly states that "Applicant does not show any variable in the claims in which is Applicant considered as a result-effective variable."

Appellants discuss the errors in this assertion in detail on page 16 of Appellants' Brief on Appeal. In making the assertion that the Advisory Action does, this substantively ignores the requirement of the Patent Office, rather than the Appellant, to provide a showing that "[a] particular parameter [is first] recognized as a result-effective variable." The burden is not on Appellants, but rather on the Patent Office to provide such a showing, which simply has not been done in this matter.

The Examiner's Answer interestingly cites to allegedly new prior art which was not included as any basis for rejecting any claim in the June 15 Final Rejection. *See, specifically*, the reference to U.S. Patent No. 6,076,217 to Brunelli in the first full paragraph in the Response to Arguments section on page 5 of the Examiner's Answer. Interestingly, the Examiner's Answer now cites to a different portion of the MPEP for the proposition that "similarly, a *prima facie* case of obviousness exists where the claimed ranges and prior art ranges do not overlap but are close enough that one skill [sic] in the art would have expected them to have the same properties." *Id.* As is clear from Appellants' disclosure, one of skill in the art would not have expected the claimed ranges and prior art ranges "to have the same property." The Examiner's Answer makes the statement that the Examiner considers the ranges are "close enough that one skill [sic] in the art would have expected them to have the same properties," but provides no evidence of record to support this conclusion made, for the first time, in the Examiner's Answer.

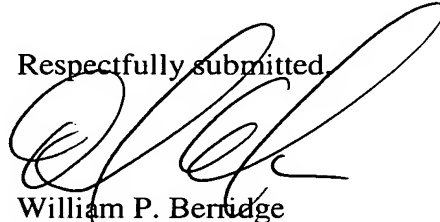
Appellants believe that the detail provided in the argument at pages 12-16 of Appellants' Brief on Appeal, with liberal citation to the explicit teachings of Dickey, specifically rebut the unsupported statement in the Examiner's Answer, where the Examiner concludes, without evidence, that one of skill in the art would have expected the claimed

ranges to have the same properties as those disclosed in Dickey. In the cited portions of Appellants' disclosure discussed above, it is clear that one of skill in the art would not have expected the recited ranges to have the same properties as the prior art ranges. Again, the Office Action specifically overlooks the evidence provided in Appellants' disclosure where it states "[n]ote that the specification contains no disclosure of either the critical nature of the claimed ranges or any unexpected results arising therefrom." *See* page 6 of the Examiner's Answer. This statement, as indicated above, is specifically incorrect. Also, as did the Advisory Action, the final statement in the Examiner's Response to Arguments reverses the roles of proof required regarding what may be considered a result-effective variable. *Id.* This is not Appellants' burden. Specifically, the Examiner's Answer states "the present specification does not provide result for showing that the claimed ranges are result-effective variables." The Examiner's Answer, once again, attempts to reverse the roles regarding the Patent Office's burden to prove that a particular parameter "must *first* be recognized as a result-effective variable."

For all of the reasons set forth above, in addition to the specific arguments made in Appellants' Brief on Appeal, a *prima facie* case of obviousness with respect to independent claim 1 of this application, and claims 3-6 depending therefrom, has not been made.

Accordingly, it is respectfully submitted that the rejection is in error, and that claims 1 and 3-6 are in condition for allowance. For all of the above reasons, in addition to those set forth in Appellants' Brief on Appeal, Appellants respectfully request this Honorable Board to reverse the rejection of claims 1 and 3-6.

Respectfully submitted,



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WPB:DAT/raw

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